



UNITED STATES DEPARTMENT OF COMMERCE
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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
07/142,888	01/11/88	GIBSON	S SPC6947/6970

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EXAMINER	
PESELEV, E	
ART UNIT	PAPER NUMBER
103	3

DATE MAILED:

11/14/89

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449 | 4. <input type="checkbox"/> Notice of informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474 | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-40 are pending in the application.
Of the above, claims 36-39 are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-35 and 40 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.
8. ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. These drawings are ☐ acceptable; ☐ not acceptable (see explanation).
10. ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved. ☐ disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.
12. ☒ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☒ not been received
☐ been filed in parent application, serial no. _____; filed on _____
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

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Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-35 and 40, drawn to avermectin derivatives and compositions containing the same, classified in Class 514, subclass 30.

II. Claims 36-39, drawn to a fermentation process for preparing said avermectin derivatives, classified in Class 435, subclass 76.

The inventions are distinct, each from the other, because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different products, or (2) the product as claimed can be made by another and materially different process. (MPEP 806.05(f)).

In the instant case, the product as claimed can be made by a materially different process such as chemical synthetic modification of known avermectin derivatives.

Because these inventions are distinct for the reasons given above, and have acquired a separate status in the art as shown by their different classification, the search required for Group I is not required for

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Group II, restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement may be traversed. (37 CFR 1.143).

During a telephone conversation with J. Trevor Lumb on October 25, 1989 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-35 and 40. Affirmation of this election must be made by applicant in responding to this Office action, and such affirmation must distinctly and specifically point out the reasons upon which applicant bases his or her conclusion that the requirement to restrict is in error. Claims 36-39 are withdrawn from further consideration by the Examiner, 37 CFR 1.142(b), as being drawn to a nonelected invention.

Applicant is reminded that upon the cancellation of claims to a nonelected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

35 U.S.C. 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of

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matter or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title".

Claims 1-35 and 40 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 3-5 and 7-9 of copending application Serial No. 279,749.

This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claims 1, 3-35 and 40 are provisionally rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1, 3-5 and 7-9 of copending application Serial No. 279,749. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed compounds are within the scope of the compounds claimed in the copending application Serial No. 279,749.

This is a provisional obviousness type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 33-35 and 40 are rejected under 35 U.S.C. 112, first paragraph, as the disclosure is enabling only for claims limited in accordance with the specific embodiments. See MPEP 706.03(n) and 706.03(z).

The term "prevention" (claims 33-35) lacks enablement since it encompasses treatment of healthy animals

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and preventing the same from getting an infection while the data in the specification provides support only for treating infections. The method claim 40 lacks enablement since the host has not been set forth.

Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The terminology "R³ is methyl and R³ is 3-thienyl" renders the claims indefinite since there is no antecedent basis in claim 1 for R³ representing 3-thienyl group.

The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to

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the same person.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103.

Claims 1-3, 13, 17, 28, 33-35 and 40 are rejected under 35 U.S.C. 103 as being unpatentable over Mrozik.

Mrozik discloses avermectin and milbemycin anti-parasitic agents having at the 25 position methyl, ethyl, iso-propyl or sec-butyl and compositions containing the same but does not disclose avermectin and milbemycin compounds containing at the 25-position n-propyl or n-butyl groups. Since propyl is a next higher homolog^o of ethyl and is an isomer of an iso-propyl group and since n-butyl is a positional isomer of the sec-butyl group, it would have been obvious to a person having ordinary skill in the art to substitute n-propyl and n-butyl group for ethyl, iso-propyl and sec-butyl at the time of the instant invention on a compound shown by Mrozik since homolog^oues and positional isomers are obvious variants of each other in the absence of verified data showing patentably distinct unexpected results.

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The instant compounds, composition and method are deemed obvious therefrom.

Claims 1-3, 13, 17, 28, 33-35 and 40 are rejected under 35 U.S.C. 103 as being unpatentable over the British patent '436 in combination with Mrozik.

The British patent '436 discloses milbenycin derivatives having hydrogen at the 13-position and an alkenyl group at the 25-position and a composition containing the same ~~which~~ possessing antibiotic activity but does not disclose milbenycin derivatives having a sugar moiety at the 13-position. Since Mrozik discloses interchangeability of hydrogen and a sugar moiety at the 13-position of a closely analogous milbenycin derivative, it would have been obvious to a person having ordinary skill in the art at the time of the instant invention to substitute a sugar moiety for a hydrogen at the 13-position of milbenycin derivative disclosed by the British patent '436 with an expected result. The instant compounds, composition and method are deemed obvious therefrom.

Any inquiry concerning this communication should be directed to Elli Peseler at telephone number 703-557-3634.

EW
Elli Peseler:dm

(703) 557-3634

November 8, 1989

JOHNNIE R. BROWN
SUPERVISORY PATENT EXAMINER
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